

ESTTA Tracking number: **ESTTA739832**

Filing date: **04/13/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	JABBER MEDIA LLC		
Entity	limited liability company	Citizenship	Michigan
Address	209 Park Street Troy, MI 48083 UNITED STATES		

Attorney information	Julie A. Greenberg Dinsmore & Shohl 900 Wilshire, Suite 300 Troy, MI 48084 UNITED STATES litigation@patlaw.com Phone:2486476000
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Registration Subject to Cancellation

Registration No	2838324	Registration date	05/04/2004
Registrant	Yeager, Joseph Luxembourg Corporate Center Langhorne, PA 19047 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 1993/03/01 First Use In Commerce: 1993/03/01 All goods and services in the class are cancelled, namely: business consulting services and business and market research services

Grounds for Cancellation

Fraud on the USPTO	Trademark Act section 14;In re Bose Corp., 580 F.3d 1240, 91 USPQ2D 1938 (Fed. Cir. 2009)
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Attachments	Petition to Cancel.pdf(49603 bytes) ExhibitA.pdf(596483 bytes) Exhibit B.pdf(34057 bytes) Exhibit C1.pdf(126812 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Julie A. Greenberg/
Name	Julie A. Greenberg
Date	04/13/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark
Registration No. 2838324
Mark: JABBERRS
Filing Date: July. 24, 2003
Registered: May 04, 2004
-----)

JABBER MEDIA LLC

Petitioner,

v.

Cancellation No. _____

Joseph Yeager

Registrant.
-----)

PETITION FOR CANCELLATION

NOW COMES Petitioner JABBER MEDIA LLC ("Petitioner"), by and through counsel, and Petitions to Cancel Registration No. 2,838,324 (the "'324 Registration") owned by Joseph Yeager (deceased) ("Registrant") for the mark JABBERRS (the "Registered Mark"), in connection with business consulting services and business and market research services in Class 35.

In support of this Petition for Cancellation, Petitioner states that it is now and will continue to be damaged by the continued presence on the Principal Register of the '324 Registration, and hereby petitions to cancel the '324 Registration under the provisions of Section 14 of the Trademark Act of 1946 ("Lanham Act"), 15 U.S.C. § 1064(3), and in accordance with the provisions of T.B.M.P. § 307.01. Petitioner states that the Registration is void *ab initio* because the Registered Mark was not used in interstate

commerce at the time the use-based application for the '324 Registration was filed, nor, on information and belief, has the Registered Mark been used in commerce at any time since. Additionally, on information and belief, the Registered Mark has not been used for at least three years, and has thus become abandoned, if it was ever used in commerce. Additionally, by submitting the identical specimen (Exhibit A) three times over ten years, which specimen never reflected bona fide use in commerce, and which Registrant knowingly submitted as false evidence of continued use, Registrant has committed repeated fraud on the Trademark Office. Finally, Petitioner states that, even if the Registration is not void or abandoned, it is overly broad for the reason that it is being construed by the Trademark Examiner as being used on services which are related to, and thus likely to be confused with, Petitioner's advertising services, when in fact Registrant does not use the services in connection with advertising of any kind, and the Registered Mark is not likely to be confused with the mark JABBER MEDIA of Petitioner's pending application, SN 86554254. (See Exhibit B). As a result, the description of goods of the Registration should be corrected to accurately reflect the consulting services in connection with which the Registered Mark is registered and allegedly used.

As set forth more fully below, if the Petition to Cancel is not granted, and the Registration is permitted to remain on the Principal Register, Petitioner will be harmed by the refusal under Section 2(d) preventing registration of Petitioner's own mark, SN 86554254. Moreover, Petitioner will be harmed by the presumption of exclusive rights granted to Registrant by virtue of the Registration, even though the Registration is not based on rights protected by the Lanham Act.

In support of its Petition for Cancellation, Petitioner alleges as follows:

1. Petitioner is a Michigan Limited Liability Company with a principal place of business at 209 Park Street, Troy MI 48083.
2. Petitioner owns pending trademark application SN 86554254 (hereinafter referred to as "Petitioner's Application") for the mark JABBER MEDIA for the following services: "Advertising, marketing and promotional services for others; design and distribution of advertising and promotional materials for others for online, print and electronic media; development of advertising materials and campaigns, namely, advertising retargeting, marketing, search engine optimization, designing and developing advertisements and advertising programs for distribution in print, online, through social networks, mobile computing devices and mobile phones, providing a website featuring advertising for others; development and implementation of social media campaigns to promote goods and services of others." Petitioner's Application was filed Mar. 05, 2015 based on intent-to-use.
3. Petitioner's Application has been refused registration under 15 USC §1052(d) based on grounds that Petitioner's Application is likely to be confused with the '324 Registration. (See Exhibit C).
4. The named Registrant of the '324 Registration is Joseph Yaeger, on information and belief a deceased individual,
5. When filing the application on July 24, 2003 for the '324 Registration, Registrant claimed a date of first use of use of March 1, 1993. Registrant submitted a specimen

with the application which he claimed established use of the mark prior to the filing date of the application. The specimen is attached hereto as Exhibit A.

6. On information and belief, Registrant had never offered or sold the purported services outside of the Commonwealth of Pennsylvania prior to filing the '324 Registration. As a use-based registration based with no interstate use, the '324 Registration is void *ab initio*.

7. On information and belief, Registrant's services have still never been provided to purchasers outside of the Commonwealth of Pennsylvania at any time, or, at least have not been sold to out-of-state purchasers for at least three years, and thus the Registered mark has been abandoned.

8. The specimen filed by Registrant to show use of the Registered Mark at the time of filing the '324 Registration in 2003 is not an acceptable specimen showing trademark use consistent with the TMEP. In particular, it fails to comply with TMEP 1301.04, which states "a service-mark specimen must show the mark as actually used *in the sale or advertising of the services* recited in the application." The specimen is simply a statement on letterhead explaining Registrant's academic analysis for how customers view the world, using an acronym JABBERRS: Justifications, Alibi's, But's, Because, Excuses, Reasons and Rationales. No services are offered, sold, or even mentioned by the specimen, much less services identified by the service mark JABBERRS. On information and belief, no services have ever been offered using the Registered Mark, with this or any other specimen.

9. The specimen submitted by Registrant *five years after the filing of the application*, in support of the Section 8&15 Declaration, is the *exact same (flawed) specimen submitted by Registrant at the time of filing the application*. As with its original submission, it does not show use in connection with the advertising or sale of any service, much less a service identified as JABBERRS. Indeed, the specimen appears to be simply resubmitted to support the affidavit, with no purported service mark use. In knowingly submitting a specimen to establish service mark use, when the mark is not, and has never been used in connection with the sale or advertising of any service, much less used in interstate commerce for such service, Registrant has committed fraud on the Trademark Office.

10. The specimen submitted by Registrant *ten years after the filing* of the application, in support of the Renewal of the '324 Registration is again the exact same (flawed) original specimen submitted by Registrant at the time of filing the application. As with its original submission, it does not show use in connection with the advertising or sale of any service, much less a service identified as JABBERRS. Indeed, the specimen appears to be simply resubmitted to support the renewal affidavit, with no purported service mark use. In knowingly submitting a specimen to establish service mark use, when the mark is not, and has never been used in connection with the sale or advertising of any service, much less used in interstate commerce for such service, Registrant has committed fraud on the Trademark Office.

11. Even if the Registered Mark was used in interstate commerce prior to the filing of the use-based application, such that the Registration is not void *ab initio*, the failure to

use the Registered Mark for at least three years constitutes abandonment of the Registered Mark.

WHEREFORE, Petitioner prays that the Registration be cancelled on the following grounds:

1. The Registration is void *ab initio* as claiming interstate use prior to filing where no interstate use (sales outside the Commonwealth of Pennsylvania) existed;
2. The Registration is void for having been based on a mark which was never used in connection with the promotion or sale of any service at any time.
3. The Registration is void for having failed to be supported by a proper specimen showing the advertising or sale services in connection with the Registered Mark.
4. The Registration is void on the grounds of fraud as a result of Registrant knowingly submitting the identical (flawed) specimen three times over ten years despite the fact no services were actually being offered or promoted, the specimen was not actually being used in commerce, and did not show use of the Registered Mark in commerce.
5. The Registered Mark has been abandoned, if it was ever used in interstate commerce, for having not been used in interstate commerce for a period of three years prior to the filing of this Petition to Cancel.

Petitioner hereby appoints as its attorneys Julie A. Greenberg and Dinsmore & Shohl PC, having an address at 900 Wilshire, Suite 300, Troy, Michigan, 48007 with full power to prosecute said action, to transact all relative business in the U.S. Patent and Trademark Office and to receive all official communications in connection therewith.

The filing fee(s) required for this Petition for Cancellation have been electronically submitted herewith.

DINSMORE & SHOHL LLP

By: /Julie A. Greenberg/
Julie A. Greenberg P38299
DINSMORE & SHOHL LLP
900 Wilshire, Suite 300
Troy, MI 48084
(248) 647-6000

Dated: April 13, 2016

CERTIFICATE OF ELECTRONIC FILING AND OF SERVICE

The undersigned hereby certifies that a true and correct copy of the forgoing PETITION FOR CANCELLATION was electronically filed with the TTAB via the ESTTA Filing System on April 13, 2016 with the same being served upon counsel of record for the Registrant by e-mail and U.S. Mail, postage prepaid and addressed as follows:

Jordan A. LaVine
Flaster Greenberg
Four Penn Center
1600 John F. Kennedy Blvd.
2nd Floor
Philadelphia, PA 19103
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/Julie A. Greenberg/
Julie A. Greenberg P38299
ATTORNEYS FOR PETITIONER
JABBER MEDIA LLC

J O S E P H Y E A G E R , P H . D .

JABBERRS™

Customers present sharp challenges to understanding among marketing executives. Emotions, impulses and seeming irrationality among customers become difficult to read.

Gaining insight into the murky world of customer logic require analytic tools that can pierce the obscuring effects of customer JABBERRS™.

Customers view the world through their unique subjectivity as represented by their Justifications, Alibi's, But's, Because's, Excuses, Reasons and Rationales.

Customers present their world view in such a way that marketers need tools to cut through the confusion of what customer say compared to what customers mean.

Exclusive analytic technology, developed by Joseph Yeager, Ph.D. is available through Sommer Consulting, Inc. to cut through the confusion of customer rationales to provide answers to moving customer minds.

Yeager's motivational profiles provide the state of the art in recognizing the keys to customer persuasion that lead to marketing success.

408 Executive Drive Langhorne, PA 19047
215-860-8152

JCY@SOMMERCONSULTINGINC.COM

EXHIBIT B

Generated on: This page was generated by TSDR on 2016-04-13 16:00:02 EDT

Mark: JABBER MEDIA

JABBER MEDIA

US Serial Number: 86554254

Application Filing Date: Mar. 05, 2015

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

Status: A final Office action refusing registration has been sent (issued) because the applicant neither satisfied nor overcame all requirements and/or refusals previously raised. The applicant may respond by filing (1) a request for reconsideration; and/or (2) an appeal to the Trademark Trial and Appeal Board. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Dec. 30, 2015

Mark Information

Mark Literal Elements: JABBER MEDIA

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Disclaimer: "MEDIA"

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "*" identify additional (new) wording in the goods/services.

For: Advertising, marketing and promotional services for others; design and distribution of advertising and promotional materials for others for online, print and electronic media; development of advertising materials and campaigns, namely, advertising retargeting, marketing, search engine optimization, designing and developing advertisements and advertising programs for distribution in print, online, through social networks, mobile computing devices and mobile phones, providing a website featuring advertising for others; development and implementation of social media campaigns to promote goods and services of others

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: Yes

Currently ITU: Yes

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Jabber Media LLC

Owner Address: 209 Park Street
Troy, MICHIGAN 48007

UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country MICHIGAN
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Julie A. Greenberg

Docket Number: AVD-13119/03

Attorney Primary docket@patlaw.com

Attorney Email Yes

Email Address:

Authorized:

Correspondent

Correspondent JULIE A. GREENBERG

Name/Address: Gifford Krass Et Al
2701 Troy Center Dr Ste 330
Troy, MICHIGAN 48084-4741
UNITED STATES

Phone: 248-647-6000

Fax: 248-647-5210

Correspondent e-mail: docket@patlaw.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Dec. 30, 2015	NOTIFICATION OF FINAL REFUSAL EMAILED	
Dec. 30, 2015	FINAL REFUSAL E-MAILED	
Dec. 30, 2015	FINAL REFUSAL WRITTEN	90297
Dec. 16, 2015	TEAS/EMAIL CORRESPONDENCE ENTERED	73296
Dec. 16, 2015	CORRESPONDENCE RECEIVED IN LAW OFFICE	73296
Dec. 10, 2015	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jun. 10, 2015	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Jun. 10, 2015	NON-FINAL ACTION E-MAILED	6325
Jun. 10, 2015	NON-FINAL ACTION WRITTEN	90297
Jun. 10, 2015	ASSIGNED TO EXAMINER	90297
Mar. 26, 2015	APPLICANT AMENDMENT PRIOR TO EXAMINATION - ENTERED	73296
Mar. 20, 2015	ASSIGNED TO LIE	73296
Mar. 18, 2015	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Mar. 11, 2015	TEAS VOLUNTARY AMENDMENT RECEIVED	
Mar. 11, 2015	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Mar. 09, 2015	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: JACKSON, ELIZABETH FLE

Law Office LAW OFFICE 113
Assigned:

File Location

Current Location: TMO LAW OFFICE 113 - EXAMINING
ATTORNEY ASSIGNED

Date in Location: Dec. 30, 2015

EXHIBIT C

To: Jabber Media LLC (docket@patlaw.com)

Subject: U.S. TRADEMARK APPLICATION NO. 86554254 - JABBER MEDIA - AVD-13119/03

Sent: 12/30/2015 11:45:46 AM

Sent As: ECOM113@USPTO.GOV

Attachments: [Attachment - 1](#)
[Attachment - 2](#)
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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 86554254

MARK: JABBER MEDIA

CORRESPONDENT ADDRESS:

JULIE A. GREENBERG
Gifford Krass Et Al
2701 Troy Center Dr Ste 330
Troy, MI 48084-4741

APPLICANT: Jabber Media LLC

86554254

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

[VIEW YOUR APPLICATION FILE](#)

CORRESPONDENT'S REFERENCE/DOCKET NO :

AVD-13119/03

CORRESPONDENT E-MAIL ADDRESS:

doCKET@patlaw.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 12/30/2015

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on December 10, 2015.

In a previous Office action dated June 10, 2015, the trademark examining attorney refused registration of the applied-for mark based on the following: Trademark Act Section 2(d) for a likelihood of confusion with a registered mark. In addition, applicant was required to satisfy the following requirements: amend the identification of services, clarify the number of classes for which registration is sought, and disclaim descriptive wording in the mark.

The examining attorney has thoroughly reviewed the applicant's response. The Disclaimer Requirement is **SATISFIED**. The requirement to clarify the number of classes for which registration is sought is **SATISFIED**. The applicant has amended the identification of services; however, the applicant has amended the identification of services beyond the scope of the initial identification. Furthermore, the applicant has not provided any arguments against the Section 2(d) Refusal. ***For the reasons set forth below, the refusal under Trademark Act Section 2(d) is now made FINAL with respect to U.S. Registration No. 2838324. See 15 U.S.C. §1052(d); 37 C.F.R. §2.63(b). In addition, the identification of services requirement is now made FINAL. See 37 C.F.R. §2.63(b).***

SUMMARY OF ISSUES:

- **Section 2(d) Refusal—Likelihood of Confusion**
- **Identification of Services Requirement**

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 2838324. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

In the instant case, applicant has applied to register the mark **JABBER MEDIA** for “advertising, marketing and promotional services for others; design and distribution of advertising and promotional materials for others for online, print and electronic media; development of advertising materials and campaigns, namely, advertising retargeting, marketing, search engine optimization, designing and developing advertisements and advertising programs for distribution in print, online, through social networks, mobile computing devices and mobile phones, providing a website featuring advertising for others; development and implementation of social media campaigns to promote goods and services of others” in Class 35.

The mark in Registration No. 2838324 is **JABBERRS** for “business consulting services and business and market research services” in Class 35.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the services, and similarity of the trade channels of the services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Similarity of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Profs., Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

In the instant case, applicant’s mark **JABBER MEDIA** is confusingly similar to the mark **JABBERRS** in Registration No. 2838324. Specifically, the word **JABBER** in the applicant’s mark is highly similar in appearance to the word **JABBERRS** in the registrant’s mark, that is, both marks begin with the letters **JABBER**. In addition, because the registrant’s mark merely repeats the letter “R,” purchasers are likely to pronounce the portion **JABBERR** in the registrant’s mark in the same way as the entirety of the applicant’s mark **JABBER**. Please note that the Trademark Trial and Appeal Board has held that an applied-for mark that is the singular form of a registered mark is essentially identical in sound, appearance, meaning, and commercial impression, and thus the marks are confusingly similar. *Swiss Grill Ltd., v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2011 n.17 (TTAB 2015) (holding “it is obvious that the virtually identical marks [the singular and plural of SWISS GRILL] are confusingly similar”); *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (finding the singular and plural forms of SHAPE to be essentially the same mark) (citing *Wilson v. Delaunay*, 245 F.2d 877, 878, 114 USPQ 339, 341 (C.C.P.A. 1957) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark). Accordingly, in this case, the wording **JABBERRS** is highly similar, if not essentially identical, to the word **JABBER** in the applicant’s mark.

Lastly, because the registrant’s mark appears to be an intentional misspelling of the known word **JABBER**, both marks convey the same meaning, that is, rapid or unintelligible talking. See <https://www.ahdictionary.com/word/search.html?q=jabber>. This is an arbitrary and thus strong and memorable trademark for advertising and business services.

The additional word **MEDIA** in the applicant’s mark does not obviate the similarities between the marks. First, consumers are generally more inclined to focus on the first word, prefix, or syllable in any service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions). Accordingly, in this case, purchasers will focus on the initial term **JABBER** in the applicant’s mark and believe—mistakenly—that it identifies the same source of services as the registrant’s mark **JABBERRS**.

Second, although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party’s services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat’l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii). In this case, the applicant has disclaimed the word **MEDIA**, thereby acknowledging that purchasers will understand this word as merely describing the nature of applicant’s advertising services and thus focus on the initial memorable word **JABBER** to identify the source of those advertising services. Because the dominant word in applicant’s mark is highly similar in sound and appearance and conveys the same impression as the registrant’s mark, purchasers are likely to be confused as to the source of the services. Thus, the marks are confusingly similar.

The applicant has not provided any arguments against the examining attorney’s conclusion that the marks are confusingly similar.

Relatedness of the Services

The services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

In this case, the applicant’s “Advertising, marketing and promotional services for others; design and distribution of advertising and promotional

materials for others for online, print and electronic media; development of advertising materials and campaigns, namely, advertising retargeting, marketing, search engine optimization, designing and developing advertisements and advertising programs for distribution in print, online, through social networks, mobile computing devices and mobile phones, providing a website featuring advertising for others; development and implementation of social media campaigns to promote goods and services of others” are related to the registrant’s “business consulting services and business and market research services.” Specifically, the previously attached websites from Sol Marketing and Fabcom and the newly attached websites from Allied Effect, Estland Design, Frost & Sullivan, Half a Bubble Out, Illumination Consulting, Lucintel, McCartney, Navigant, Strategy Analytics, and Traverse Research N’ Consulting show that many companies that provide various advertising services like the applicant also provide business consultation or market research services like the registrant. See <http://alliedeffect.com/colorado-advertising-services/colorado-marketing/print-advertising/>; <http://alliedeffect.com/colorado-advertising-services/brand-development-process/small-business-consulting-services/>; <http://estlanddesign.com/business-consulting/>; <http://estlanddesign.com/services/>; <http://ww2.frost.com/index.php/consulting/industry-expertise/business-financial-services/>; <http://ww2.frost.com/research/>; <http://www.halfabubbleout.com/our-services/consulting/>; <http://illuminationconsulting.com/services/marketing-services/pay-per-click/>; <http://illuminationconsulting.com/services/consulting-services/>; <http://www.lucintel.com/>; http://www.lucintel.com/consulting_capability.aspx; <http://www.mccartneymultimedia.com/index.php/advertising/>; <http://www.mccartneymultimedia.com/index.php/consulting/>; <http://www.navigantresearch.com/research/>; <http://www.navigant.com/NavigantConsulting/Services/Management-Consulting/>; <https://www.strategyanalytics.com/>; <https://www.strategyanalytics.com/strategy-analytics/what-we-do/consulting#.VoMP7U2FNmN>; <https://www.strategyanalytics.com/strategy-analytics/what-we-do/consulting/our-processes#.VoMP7U2FNmN>; <http://www.traversernc.com/business-consulting.html>; <http://www.traversernc.com/quantitative-research.html>. This evidence establishes that the same entity commonly provides the relevant services and markets the services under the same mark. Accordingly, purchasers are likely to be confused as to the source of the services when they encounter advertising and marketing services offered under a highly similar mark as business consultation and market research services. Therefore, applicant’s and registrant’s services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Section 2(d) that services are related. See, e.g., *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007). The Internet has become integral to daily life in the United States, with Census Bureau data showing approximately three-quarters of American households used the Internet in 2013 to engage in personal communications, to obtain news, information, and entertainment, and to do banking and shopping. See *In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1642 (TTAB 2015) (taking judicial notice of the following two official government publications: (1) Thom File & Camille Ryan, U.S. Census Bureau, Am. Cmty. Survey Reports ACS-28, *Computer & Internet Use in the United States: 2013* (2014), available at <http://www.census.gov/content/dam/Census/library/publications/2014/acs/acs-28.pdf>, and (2) The Nat’l Telecomms. & Info. Admin. & Econ. & Statistics Admin., *Exploring the Digital Nation: America’s Emerging Online Experience* (2013), available at http://www.ntia.doc.gov/files/ntia/publications/exploring_the_digital_nation_-_americas_emerging_online_experience.pdf). Thus, the widespread use of the Internet in the United States suggests that Internet evidence may be probative of public perception in trademark examination.

In addition to the previously attached Registration Nos. 4568000, 4583038, 4629774, 4635338, 4660810, 4684263, and 4709230, which all identify marketing, advertising and promotional services, including those on social media, and market research for use under the same mark, the trademark examining attorney has attached new evidence from the USPTO’s X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar services as those of both applicant and registrant in this case. See U.S. Registration Nos. 4447683, 4440363, 4576871, 4024856, 4649000, 4763641, 4808448, 4858234, and 4866510, which all identify design and development of advertising, search engine optimization, and business consultation or market research for use under the same mark. This evidence shows that the services listed therein are of a kind that may emanate from a single source under a single mark. See *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); TMEP §1207.01(d)(iii). Accordingly, purchasers are likely to be confused as to the source of the services when they encounter advertising design and development and search engine optimization offered under a highly similar mark as business consultation and market research services. Therefore, applicant’s and registrant’s services are considered related.

The applicant has not provided any arguments against the examining attorney’s conclusion that the services are related.

In summary, the marks are confusingly similar and the services are related. Therefore, purchasers are likely to be confused as to the source of the services.

Thus, the refusal under Trademark Act Section 2(d) is now made FINAL with respect to U.S. Registration No. 2838324. See 15 U.S.C. §1052(d); 37 C.F.R. §2.63(b).

IDENTIFICATION OF SERVICES REQUIREMENT

The applicant initially identified the following services: “advertising, marketing and promotional services for others; design and printing of advertising and promotional materials for others; development of advertising materials and campaigns; development and implementation of social media campaigns to promote goods and services of others” in Class 35. The examining attorney determined that certain wording in the

identification of services was indefinite and other wording was broad enough to encompass services in multiple international classes.

In response, the applicant amended the identification of services to the following:

“Advertising, marketing and promotional services for others; design and distribution of advertising and promotional materials for others for online, print and electronic media; development of advertising materials and campaigns, namely, advertising retargeting, marketing, search engine optimization, designing and developing advertisements and advertising programs for distribution in print, online, through social networks, mobile computing devices and mobile phones, providing a website featuring advertising for others, providing an online platform for designing, developing, implementing and managing advertisements and advertising campaigns; development and implementation of social media campaigns to promote goods and services of others” in Class 35

The wording “providing an online platform for designing, developing, implementing and managing advertisements and advertising campaigns” in the proposed amendment to the identification is not acceptable because it exceeds the scope of the identification in the application. *See* 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.*, 1402.07. The original identification in the application, and any previously accepted amendments, remain operative for purposes of future amendment. *See* 37 C.F.R. §2.71(a); TMEP §1402.07(d).

An acceptable identification of services is required in an application. *See* 37 C.F.R. §§2.32(a)(6), 2.71(a); TMEP §§805, 1402.01. An applicant may only amend an identification to clarify or limit the services, but not to add to or broaden the scope of the services. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07. Scope is generally determined by the ordinary meaning of the wording in the identification. TMEP §1402.07(a).

The application originally identified a variety of advertising services.

However, the proposed amendment identifies the services as follows: “providing an online platform for designing, developing, implementing and managing advertisements and advertising campaigns.”

This portion of the proposed amendment is beyond the scope of the original identification because it is a technological service in Class 42, not an advertising service in Class 35.

Thus, the identification, incorporating this amendment, is not acceptable. *See* 37 C.F.R. §§2.32(a)(6), 2.71(a); TMEP §§805, 1402.01. Accordingly, the identification of services states as follows:

“Advertising, marketing and promotional services for others; design and distribution of advertising and promotional materials for others for online, print and electronic media; development of advertising materials and campaigns, namely, advertising retargeting, marketing, search engine optimization, designing and developing advertisements and advertising programs for distribution in print, online, through social networks, mobile computing devices and mobile phones, providing a website featuring advertising for others; development and implementation of social media campaigns to promote goods and services of others” in Class 35

An applicant may only amend an identification to clarify or limit the services, but not to add to or broaden the scope of the services. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07.

For assistance with identifying and classifying services in trademark applications, please see the USPTO’s online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netathtml/tidm.html>. *See* TMEP §1402.04.

Thus, the requirement to amend the identification of services is now made FINAL. *See* 37 C.F.R. §2.63(b).

RESPONSE GUIDELINES

Applicant must respond within six months of the date of issuance of this final Office action or the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond by providing one or both of the following:

- (1) A response that fully satisfies all outstanding requirements and resolves all outstanding refusals.
- (2) An appeal to the Trademark Trial and Appeal Board, with the appeal fee of \$100 per class.

37 C.F.R. §2.63(b)(1)-(2); TMEP §714.04; *see* 37 C.F.R. §2.6(a)(18); TBMP ch. 1200.

In certain rare circumstances, an applicant may respond by filing a petition to the Director pursuant to 37 C.F.R. §2.63(b)(2) to review procedural issues. TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal and requirement in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. *See* 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$50 per international class of services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone without incurring this additional fee.

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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailling date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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Type of Mark

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Mark Drawing Code

(1) TYPED DRAWING

Owner

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Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: business consulting services and business and market research services. First Use: 1993/03/01. First Use In Commerce: 1993/03/01.

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